

Remarks

Claims 1-57 are pending in the Application. Entry of the amendment is respectfully requested. No new matter has been added. Reconsideration is respectfully requested.

Claim Status

Claims 21-39, 41, and 50-57 were indicated allowable if written in an independent form.

Claims 1-17, 20, 42-46, and 49 were rejected as being anticipated pursuant to 35 U.S.C. § 102(e) by Terranova (US 56,685,089).

Claim 40 was rejected as obvious pursuant to 35 U.S.C. § 103(a) over Terranova.

Claims 18-19 and 47-48 were rejected as obvious pursuant to 35 U.S.C. § 103(a) over Terranova in view of Otto (US 6,578,760).

The Claim Rejections

Claim 1

The Action alleges that Terranova teaches a fuel dispensing machine comprising a currency dispenser (52), a magnetic stripe reader (30), and an RFID tag reader (47). The Applicant respectfully disagrees with the interpretation and application of Terranova.

Terranova must teach every recited feature and relationship to sustain the rejection. However, Terranova does not explicitly or inherently teach the recited apparatus. For example, where does Terranova teach the recited RFID tag reader? It does not. It follows that Terranova does not explicitly teach an automated banking machine including an RFID tag reader that is operative to read data from an RFID tag of a user card.

Anticipation by inherency requires that the Office establish that persons skilled in the art would recognize that an RFID tag reader (being able to read data from a card RFID tag) was

"necessarily present" in Terranova. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999). However, there is no teaching in Terranova of the recited RFID tag reader. Where does Terranova even mention an RFID tag reader? Nor is there any indication that the ability to read a card RFID tag with an RFID tag reader is necessary or mandatory in Terranova. Nor has the Office proved that every remote banking system (like Terranova's) requires an RFID tag reader. It follows that Terranova does not inherently teach an automated banking machine including an RFID tag reader that is operative to read data from an RFID tag of a user card.

The record is absent the evidence necessary to support the Action's assertion of the recited RFID tag reader in Terranova. It follows that the rejection lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). Nor is the determination of patentability in the Action based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). The Office has not established anticipation, and it is respectfully submitted that the claim is allowable.

Independent claim 2

Claim 2 comprises original claim 3 written in an independent form. Terranova does not teach an automated banking machine with the ability to read both magnetic stripe data and RFID tag data from the same card slot. Terranova does not anticipate claim 2.

Independent claim 41

Claim 41 was indicated allowable if written in an independent form. The Applicant respectfully submits that claim 41 is now allowable. Terranova does not teach a user card having an RFID tag that includes data corresponding to user bank account information or user input.

Nor does Terranova link RFID tag data with a currency dispenser transaction in the manner recited. Terranova does not anticipate claim 41.

The Dependent Claims

Each of the dependent claims depends directly or indirectly from an independent claim. The Applicant has shown the independent claims to be allowable. Thus, it is asserted that the dependent claims are allowable on the same basis. Furthermore, each dependent claim additionally recites specific features and relationships that further patentably distinguish the claimed invention over the applied art.

The references, taken alone or in combination, do not teach or suggest the features and relationships that are specifically recited in these claims. Thus, it is respectfully submitted that the dependent claims are further allowable due to the recitation of such additional features and relationships.

Conclusion

The applied prior art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicant's recited invention. Allowance of all of Applicant's pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



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